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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,569	03/11/2004	Lee J. Peart	03292.101090.8	2568
66569 7590 02/25/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/708,569	PEART ET AL.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

3/11/04;3/17/04;3/19/04;8/20/04;4/29/05;5/2/05;8/23/07.



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth.

A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

#### **2164.08(a) Single Means Claim**

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said transaction device transponder" in lines 4-5, "said transponder" in line 6 and "said RFID transaction device" in lines 7-8. There are insufficient antecedent bases for these limitations in the claim.

Claims 3-11 are rejected based on their dependency on claim 2.

Claim 3 recites the limitation "said unique transaction account identifier" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 4-11 are rejected based on their dependency on claim 3.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Moon et al (US 20040010462 as fully supported by provisional application serial number 60/395606).

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Re claim 1: Moon teaches a system for completing a transaction using a transaction device comprising: a transaction device associated with a transaction device proxy code, said transaction device comprising a transaction device database for storing said transaction device proxy code (section 0023, 0027-0028; see also page 4, lines 9-26 of prov. Appl. 60/395606 “RFID”).

Re claim 2: Moon teaches a merchant system, said merchant system including a merchant system database, and a point of interaction (POI) device in communication with said transaction device transponder for transmitting and receiving data from said transponder in a contactless environment, the POI in RF communication with said RFID transaction device (section 0023, 0027-0028; see also page 4, lines 9-26 of prov. Appl. 60/395606 “RFID”).

Re claim 3: Moon teaches a transaction device account issuer system for maintaining a unique transaction account associated with said RFID transaction device, said transaction account correlated to said unique transaction account identifier, said transaction account for use in completing a transaction request (section 0021-0028; see also page 4, lines 9-26, page 5, lines 9-24 of prov. Appl. 60/395606 “RFID”).

Re claim 4: Moon teaches wherein said transaction device account issuer system provides said unique transaction device account identifier and said transaction device proxy code to said transaction device database, said transaction device proxy code stored on said transaction device

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database (section 0027; see also page 4, lines 9-26, page 5, lines 9-24 of prov. Appl. 60/395606).

Re claim 5: Moon teaches wherein said transaction device provides said proxy code and said transaction device identifier to said merchant system POI, said merchant system associating said proxy code and said transaction device identifier to said transaction request (section 0023-0026; see also page 4, lines 9-26, page 5, lines 9-24 of prov. Appl. 60/395606).

Re claim 6: Moon teaches wherein said merchant system provides at least said transaction device identifier and said transaction request to said issuer system (section 0023-0026; see also page 4, lines 9-26, page 5, lines 9-24 of prov. Appl. 60/395606).

Re claim 7: Moon teaches wherein said issuer system correlates said transaction device identifier to said unique transaction account, said issuer system satisfying said transaction request relative to said unique transaction account (section 0027; see also page 4, lines 9-26, page 5, lines 9-24 of prov. Appl. 60/395606).

Re claim 12. Moon teaches a method for completing a transaction in a contactless environment said method including: providing a proxy code and a transaction account identifier to a radio frequency identification (RFID) transaction device (section 0023, 0027-0028; see also page 4, lines 9-26 of prov. Appl. 60/395606 “RFID”); facilitating the providing of said proxy code and said transaction account identifier to a merchant system (section 0023, 0026-0028; see also page 4, lines 9-26 and page 5, lines 9-24 of prov. Appl. 60/395606 “RFID”); facilitating the providing

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of said proxy code and said transaction device identifier to a transaction device issuer system, said transaction device issuer system maintaining a transaction device account correlative to the transaction account identifier (section 0023, 0027-0028; see also page 4, lines 9-26 and page 5, lines 9-24 of prov. Appl. 60/395606 “RFID”); and facilitating the completion of a transaction request correlative to the transaction device account (section 0023, 0025-0028; see also page 4, lines 9-26 and page 5, lines 9-24 of prov. Appl. 60/395606).

Re claim 13. Moon teaches correlating the proxy code a distinct transaction device (section 0028).

Re claim 14. Moon teaches correlating the proxy code to a distinct transaction account issuer system (section 0020, 0028).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moon in view of Johnson, Jr. (US 6078888).

Re claims 8-9: Moon does not explicitly teach wherein said transaction device account identifier is encrypted prior to providing said transaction device identifier to said merchant system; and wherein said encrypted transaction device identifier is decrypted by said issuer system prior to said issuer system correlating said transaction device identifier to said unique transaction account. However, Johnson teaches encryption and decryption of data between transponder and a host through a POS device (col. 3, lines 45-64). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Moon to include encryption of data before sending it to the merchant system and decryption of the encrypted data by the issuer for the obvious reason of enhancing the security of the account identifier.

Re claim 10: Moon teaches wherein said proxy code is unique to said RFID transaction device account (section 0028).

Re claim 11: Moon teaches wherein said proxy code is unique to said issuer system (section 0028, 0020).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691

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